

1 REMARKS

2 Status of the Claims

3 Claims 1-21, 23-42, and 44 remain pending in the application, Claims 1, 13-18, 20, and 25  
4 being amended to more clearly define the invention, and Claims 22 and 43 having been previously  
5 cancelled.

6 Claims Rejected Under 35 U.S.C. § 112

7 The Examiner has rejected Claims 13-18 and 20 under 35 U.S.C. § 112, second paragraph, as  
8 being indefinite for failing to particularly point out and distinctly claim the subject matter which  
9 applicant regards as the invention.

10 The Examiner notes that Claims 13-18 and 20 recite the limitation "the step of enabling  
11 communication" and that there is insufficient antecedent basis for this limitation in the claims.  
12 Accordingly, Claims 13-18 and 20 have been amended to eliminate reference to this phrase.

13 Claims Rejected Under 35 U.S.C. § 102(e)

14 The Examiner has rejected Claims 1-17, 19-21, 24-38, and 40-42 as being anticipated by  
15 Wang et al. (U.S. Patent No. 6,668, 376 hereinafter referred to as "Wang"). The Examiner asserts  
16 that Wang describes each element of applicants' claimed invention. Applicants respectfully disagree  
17 for the reasons discussed below.

18 In the interest of reducing the complexity of the issues for the Examiner to consider in this  
19 response, the following discussion focuses on amended independent Claims 1 and 25. The  
20 patentability of each remaining dependent claim is not necessarily separately addressed in detail.  
21 However, applicants' decision not to discuss the differences between the cited art and each dependent  
22 claim should not be considered as an admission that applicants concur with the Examiner's  
23 conclusion that these dependent claims are not patentable over the disclosure in the cited references.  
24 Similarly, applicants' decision not to discuss differences between the prior art and every claim  
25 element, or every comment made by the Examiner, should not be considered as an admission that  
26 applicants concur with the Examiner's interpretation and assertions regarding those claims. Indeed,  
27 applicants believe that all of the dependent claims patentably distinguish over the references cited.  
28 Moreover, a specific traverse of the rejection of each dependent claim is not required, since  
29 dependent claims are patentable for at least the same reasons as the independent claims from which  
30 the dependent claims ultimately depend.

1 The Examiner asserts that the claimed limitation of applicants' step (d) of Claim 1 that recites  
2 suppressing further requests to execute a browser function to access the network address to obtain  
3 information not essential for the use of the peripheral device relates to nothing more than the broad  
4 concept of browsing the web at the choice of the user (Office Action, pages 8-9). In addition, the  
5 Examiner asserts that Wang disclosed the use of the Microsoft Internet Explorer and Netscape  
6 Navigator browsers which were well known in the art for use in browsing web pages (Office Action,  
7 page 9). The Examiner notes that although applicants argued that in contrast to Wang, in applicants'  
8 invention, the user is given the option to suppress such browser use such as suppressing subsequent  
9 automated vendor requests that may be used to produce web advertising, that the applicants did not  
10 amend Claim 1 to recite "...suppress further **automatically generated** requests" (Office Action,  
11 page 8). Accordingly, applicants have amended Claim 1 to further clarify and distinguish their  
12 invention from Wang's invention since applicants give the user the option to suppress such additional  
13 automatically generated requests to use a browser to access the address, so that the user need not be  
14 exposed to unwanted advertising or offers of products or services (see applicants' specification,  
15 page 12, lines 30-36).

16 Also, the Examiner asserts that Wang teaches that the URL determined from a peripheral  
17 device could be a special-case URL (column 4, lines 4-9) and thus, Wang implies that by using such  
18 a URL, the system could access and obtain non-essential information related to the use of the  
19 peripheral device as claimed. Since Wang discloses that the URLs were for different web sites that  
20 could be accessed and which contain the device drivers for use on the host computer, one of ordinary  
21 skill in the art would recognize that the web site itself is non-essential to the use of the peripheral  
22 device by the host device, as it is the device driver that is needed to operate the peripheral (Office  
23 Action, page 9). However, the reference in column 4 only discusses how an absolute URL  
24 completely describes how to obtain a file on the Internet (column 4, lines 7-9), and this sentence is  
25 part of a paragraph that discusses how the manufacturers of the devices have provided specific  
26 addresses where device drivers are available in correlation with particular identification data provided  
27 by a peripheral device so that the device driver for the peripheral device can be downloaded and  
28 installed. There is no teaching or suggestion that such a URL might include anything other than a  
29 device driver, or any information not related to the use of the peripheral device. Furthermore,  
30 applicants are not claiming that the network address itself is non-essential, but simply that by having

1 accessed the network address, *information* non-essential for the use of the peripheral device by the  
2 host device may be obtained from the network address and such information may be presented to the  
3 user automatically, unless the user selectively suppresses the web browser from automatically  
4 obtaining non-essential information (such as advertising for related products or software) from the  
5 web site. In contrast, Wang neither suggests nor teaches that the web site contains additional  
6 information that is non-essential to the use of the peripheral device.

7 Accordingly, the rejection of independent Claim 1 under 35 U.S.C. § 102(e) over Wang  
8 should be withdrawn, since Wang neither teaches nor suggests “enabling a user to suppress further  
9 *automatically generated* requests to execute a browser function on the host device, to access the  
10 network address to obtain information not essential for the use of the peripheral device by the host  
11 device, *wherein said automatically generated requests are not initiated by the user.*”

12 Independent Claim 25 has also been amended to distinguish over Wang for reasons  
13 similar to those expressed above in connection with Claim 1. Accordingly, the rejection of  
14 independent Claims 25 over Wang under 35 U.S.C. § 102(e) should be withdrawn for the same  
15 reasons.

16 Because dependent claims are considered to include all of the elements of the independent  
17 claim from which the dependent claims ultimately depend and because the Wang reference does not  
18 disclose or suggest all of what is recited in independent Claims 1 and 25, the rejection of dependent  
19 Claims 2-17, 19-21, 24, 26-38 and 40-42 under 35 U.S.C. § 102(e) over Wang should be withdrawn  
20 for at least the same reasons noted above in the traverse of the rejection of Claims 1 and 25.

21 Claims Rejected under 35 U.S.C. § 103(a)

22 Claims 18 and 39 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang as  
23 applied to Claim 1 and Claim 25 in view of Lin et al. (U.S. Patent No. 6,523,083 hereinafter “Lin”).  
24 The Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time the  
25 invention was made to modify the method disclosed by Wang to include the step of downloading  
26 firmware, as disclosed by Lin. In addition, the Examiners asserts that applicants’ arguments fail to  
27 comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a  
28 patentable invention without specifically pointing out how the language of the claims patentably  
29 distinguishes them from the reference (Office Action, page 9). Furthermore, the Examiner asserts  
30 that in response to applicants’ arguments against the references individually, one cannot show

1 nonobviousness by attacking references individually where the rejections are based on combinations  
2 of references (Office Action, page 10).

3       However, the Examiner is respectfully urged to review MPEP 2143.03 which notes that  
4 “to establish *prima facie* obviousness of a claimed invention, all the claim limitations  
5 must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580  
6 (CCPA 1974).” For the reasons described above, the Wang reference does not teach the  
7 step recited in independent Claim 1 of suppressing further *automatically generated* requests to  
8 execute a browser function on the host device, to access the network address to obtain information  
9 not essential for the use of the peripheral device by the host device, wherein said automatically  
10 generated requests are not initiated by the user. That step is inherently included in dependent  
11 Claims 18 and 39, since it is recited in the independent claims on which these two claims  
12 respectively depend. The Examiner has rejected Claims 18 and 39 over the combined teachings of  
13 Wang and Lin, but applicants have shown that Wang does not teach that inherent step or element of  
14 Claims 18 and 39 relating to suppressing further automatically generated requests. Since that step  
15 is inherently included in both of these dependent claims, but Wang neither teaches or suggests it  
16 AND Lin also does not teach or suggest it, the combination cited by the Examiner fails to disclose  
17 the invention defined by the dependent claims. This is a very basic concept in patent law and the  
18 Examiner might want to discuss it with a Supervisory Examiner. Accordingly, the rejection of  
19 dependent Claims 18 and 39 under 35 U.S.C. § 103(a) over Wang in view of Lin should be  
20 withdrawn.

21       Claims 23 and 44 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wang as  
22 applied to Claim 1 and Claim 25 and further in view of what was well known at the time of the  
23 invention. However, for the reasons discussed above, since independent Claim 1 is clearly  
24 distinguished over Wang for the reasons described above, then Claim 23 is also patentable, since  
25 Claim 23 depends from independent Claim 1. Similarly, since independent Claim 25 is distinguished  
26 over Wang for the reasons discussed above, Claim 44 is also patentable, since Claim 44 depends  
27 from independent Claim 25. Accordingly, the rejection of dependent Claims 23 and 44 under  
28 35 U.S.C. § 103(a) over Wang in view of what was well known at the time of the invention should be  
29 withdrawn.

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1 In view of the amendments and Remarks set forth above, it will be apparent that the claims in  
2 this application define a novel and non-obvious invention, and that the application is in condition for  
3 allowance and should be passed to issue without further delay. Should any further questions remain,  
4 the Examiner is invited to telephone applicants' attorney at the number listed below.

5 Respectfully submitted,


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10 RMA/SKM:lrg

11 I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed  
12 envelope as first class mail with postage thereon fully prepaid addressed to: Commissioner for Patents,  
13 Alexandria, VA 22313-1450, on January 10, 2005.

14 Date: January 10, 2005

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